

REMARKS/ARGUMENTS

Reconsideration of this application is respectfully requested in view of the discussion presented herein.

1. Claims 15-33 are allowed.

Applicant notes with appreciation that Claims 15-33 are allowed.

2. Allowable subject matter in Claims 4-5, 8, and 10-14.

Claims 4-5, 8, and 10-14 are objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

(a) Applicant has rewritten Claim 4 in independent form including all the limitations of Claim 2, the base claim. Applicant believes that Claim 4 is now allowable.

(b) Applicant has rewritten Claim 5 in independent form including all the limitations of Claim 2, the base claim. Applicant believes that Claim 5 is now allowable.

(c) Claims 8 has been amended to depend from rewritten Claim 5. Claim 8 has also been amended to recite the means for locating for proper antecedent basis and to delete the redundant reference to a controller. Applicant believes that Claim 8 is now allowable as amended.

(d) Claim 10 has been amended to depend from rewritten Claim 5. Claim 10 has also been amended to delete the redundant reference to a controller. Applicant believes that Claim 10 is now allowable as amended.

(e) Claim 11 has been amended to depend from rewritten Claim 5. Claim 11 has also been amended to delete the redundant reference to a controller. Applicant believes that Claim 11 is now allowable as amended.

(f) Claims 12-14 have been amended to depend from rewritten Claim 5. Applicant believes that Claims 12-14 are now allowable as amended.

3. Rejection of Claim 1-3 and 6 under 35 USC § 102.

Claims 1-3 and 6 were rejected under 35 USC § 102 as anticipated by Zeck et al (6723375). The Examiner contends that, "Zeck et al. discloses the same invention as

claimed: support structure (12, 34 etc.) to maneuver along utility path, means carried by the support structure for locating (it is sensor arrangement within the support structure) and marking (paint sprayer 42) a proximate vertical position of said underground utility."

(a) In response, Applicant has amended Claim 1 to more particularly claim the invention by reciting, "an articulating arm coupling said support structure to said means for locating and marking." Support for this amendment is found in FIG. 26 and paragraph [0095] of the specification. Zeck et al. discloses a portable hand held utility locator with a paint marking apparatus but does not teach or suggest an articulating arm to position the means for marking. Further, it would not be obvious to use an articulating arm from the teaching of Zeck et al. Applicant believes that Claim 1, as amended is in condition for allowance as it recites matter not disclosed or taught in Zeck et al.

(b) Applicant has amended Claim 2 to recite, in part, "an articulating arm coupling said means for marking to said support structure," and, "means for positioning said articulating arm in response to signals from said means for locating." Support for this amendment is found in FIG. 26 and paragraph [0095] of the specification. Zeck et al. discloses a portable hand held utility locator with a paint marking apparatus but does not teach or suggest an articulating arm to position the means for marking. Zeck et al. also does not disclose a means for positioning the paint marking apparatus. Further, it would not be obvious to use an articulating arm or a means for positioning from the teaching of Zeck et al. Applicant believes that Claim 1, as amended is in condition for allowance as it recites subject matter not disclosed or taught in Zeck et al.

(c) Claim 3 depends from Claim 2. Applicant believes that Claim 2, as amended, is in condition for allowance and therefore, Claim 3 is, a fortiori, allowable.

(d) Claim 6 depends from Claim 2. Applicant believes that Claim 2, as amended, is in condition for allowance and therefore, Claim 6 is, a fortiori, allowable.

4. Rejection of Claims 7 and 9 under 35 USC §103(a).

Claims 7 and 9 were rejected as being unpatentable over Zeck et al. The

Examiner contends that, "Zeck et al discloses substantially the same invention as claimed, except for the detector means comprising a sonic detector (or other types of claimed detectors), and the controller comprising a microprocessor to receive signals and to generate control signal to the position indicating means.

In response, Applicant has amended Claims 7 and 9 to depend from rewritten Claim 5. Applicant believes that rewritten Claim 5 is allowable and, therefore, Claims 7 and 9 are allowable.

5. Amendment to Claim 33.

Applicant has amended Claim 33 to correct a typographical error and incorrect antecedent basis discovered during the preparation of this office action response. Applicant apologizes for any confusion these errors may have caused.

6. New dependent Claims 34 and 35.

(a) New Claim 34 depends from independent Claim 33 and recites an articulating arm. Support for this new claim is found in FIG. 26 and FIG. 28 and paragraph [0095].

(b) New Claim 35 depends from independent Claim 33 and recites the means for marking is a paint sprayer. Support for this amendment is found in FIG. 19 through FIG. 23 and FIG. 28.

7. Claim Fees.

Two dependent claims are rewritten to independent form. Two dependent claims have been added. Additional claim fees are required.

8. Amendments Made Without Prejudice or Estoppel.

Notwithstanding the Amendments made and accompanying remarks provided above, Applicants do not acquiesce in the original ground for election with respect to the original form of these claims. The Amendment has been made without any prejudice, waiver, or estoppel, and without forfeiture or dedication to the public, with respect to the original subject matter of the claims as originally filed. Applicants reserve the right to pursue the original scope of non-elected claims in the future, such as through a

Appl. No.: 10/616,861
Amdt. Dated: 06/22/2007
Off. Act. Dated: 03/22/2007

divisional application, for example.

9. Conclusion.

In the event any further matters remain at issue with respect to the present application, Applicants respectfully request that the Examiner please contact the undersigned below at the telephone number indicated in order to discuss such matter prior to the next action on the merits of this application.

Dated: 06/22/2007

Respectfully submitted,

A handwritten signature in black ink, appearing to read "John P. O'Banion". The signature is fluid and cursive, with a long horizontal stroke extending to the left.

John P. O'Banion, Reg. No. 33,201
Richard M. Wiesner, Reg. No. 48,748
O'BANION & RITCHEY LLP
400 Capitol Mall, Suite 1550
Sacramento, CA 95814
(916) 498-1010